

REMARKS

In response to the Office Action mailed April 22, 2004, Applicants amend their application and request reconsideration. In this Amendment, claims 3, 5, 6, 10, 21, and 34 are cancelled and new claims 40-43 are added so that claims 1, 2, 7-9, 11-15, 17-20, 22-33, and 35-43 are now pending.

Regarding the Information Disclosure Statement filed February 6, 2004, it is presumed the Examiner received the attachments. The Examiner indicated he did not consider the attachments because there was not a concise explanation of the relevance of the documents that were supplied not in the English language. Of course, an English language abstract was supplied for one of the documents. For the Examiner's further consideration and without further repetition, Applicants respectfully submit, without change, the three paragraphs of comment that appeared as part of the Information Disclosure Statement at pages 2 and 3, explaining why the documents were submitted.

A Response to the outstanding Office Action in the referenced patent application was filed on January 6, 2004. In that Response, certified English language translations of the priority documents for the present patent application were supplied in order to remove as a reference the commonly assigned U.S. Patent 6,142,874 to Kodachi et al. By perfecting the priority claim of the present patent application, Kodachi can be prior art only pursuant to 35 U.S.C. 102(e). However, in view of the common assignment of the present patent application and Kodachi, pursuant to 35 U.S.C. 103(c), Kodachi is not prior art because it would qualify only under subsection (e) of 35 U.S.C. 102 as prior art.

Out of an abundance of caution, the present Applicants are submitting with this Information Disclosure Statement Japanese Patent Application 10-146407 and the published patent application, JP-2000-42204 that corresponds to the Japanese patent application (JP 10-146407) from which Kodachi, the U.S. patent, claims priority pursuant to 35 U.S.C. 119. With regard to the foreign priority claimed, Kodachi actually filed that Japanese patent application and subsequently filed another Japanese patent application (JP 10-343330) on December 2, 1998 claiming domestic priority of the earlier Japanese patent application (JP 10-146407) filed May 27, 1998. It is the later filed application that was published. The U. S. patent to Kodachi, essentially, claimed priority of both of those Japanese patent applications and was filed within one year of the earlier-filed Japanese patent application. The publication of the Kodachi application occurred in Japan on February 15, 2000, after the filing date in Japan of the patent applications from which the present patent application claims priority.

The present U.S. patent application is a national phase of a PCT patent application filed August 24, 2000. However, the effective filing date of that U.S. application is now August 31, 1999 in view of the perfection of the priority claim of the PCT application that designated the United States. It is for that reason that it is believed the attached documents are not prior art to the present patent application. However, the Examiner is invited to make an independent analysis of these facts to determine if the publications are prior art under U.S. law, and, if so, what the effect might be, considering the perfection of the priority claim of the present patent application.

Examined claims 1-3, 5-11, 8-20, 23, and 25-32, the last item being understood to mean claims 24-32, were rejected as unpatentable over Ugawa (Japanese Published Patent Application 9-56896) considered by itself. This rejection is respectfully traversed and is essentially moot in view of the claims now pending. Claims 12-15, 17, 21, 22, and 33-39 were rejected as unpatentable over Ugawa in view of Fuchs (U.S. Patent 5,630,753). This rejection, likewise, is moot in view of the claims presented here and is respectfully traversed with respect to those claims.

Each of the pending independent claims describes a game machine or a game program that, among other features, provides a game-related production display of at least two different characters and a word design for each of the two different characters. Further, a combination of particular word designs of the two different characters indicates the probability of a special game state being achieved or the probability of a "reach", meaning a shift to a special game state in the circumstances specified in the claims. Further, the combination of word designs of the two different characters includes an exchange of words between the two different characters. This added description is fully supported in the patent application as filed, for example *original* disclosure in the passage beginning at page 18, line 14 and continuing through at least page 19, line 28. The two different characters described there are a male character and a female character. Each of the characters chats, i.e., exchanges words, with the other, resulting in the production of the word designs. The word designs, through their combination, indicating the exchange of words, gives cues to the player of a game as to the future state of the game.

Stated another way, the combination including the exchange of words between the two different characters provides an indication of whether a jackpot is likely. This ability to follow the development of the game through a scenario that includes the two characters and the word combinations of their conversation is a substantial improvement over prior games in which rapidly moving video objects have to be followed, a process that easily becomes tiresome, causing a player to lose interest in playing the game. As described in the original disclosure at page 25, lines 23-27, in the invention, it is possible for a player

to comprehend game development quickly and completely and to engage in a game with continually varying degrees of tension so that the player does not lose interest.

Ugawa, according to the English language abstract provided, is directed to maintaining the interest of a player and predicting the state of a game based upon a variable display, but there is no description or suggestion in Ugawa with regard to the use of two different characters having corresponding word designs that include exchanges of words between the two characters as part of the predictive function.

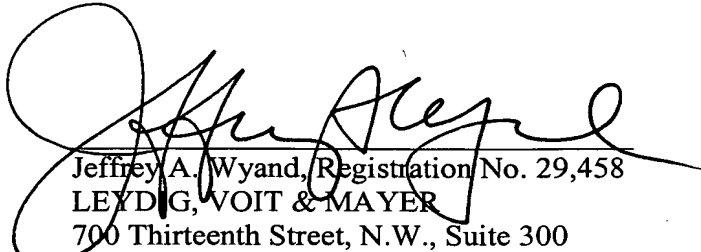
Understanding Ugawa through the computer-generated translation provided with the Office Action is exceedingly difficult. Only Figures 40(B), 43(A), 46(A), and 46(B) of Ugawa show characters with associated "word designs". In each of those figures there appears to be a single word design, although Figure 46(A) shows two characters simultaneously displayed with associated words. Figure 40(B) appears to be described in paragraph [0038], Figures 46(A) and 46(B) are described in paragraphs [0041] and [0052], and Figure 43(A) is described in paragraph [0044] of the computer-generated translation. These descriptions speak of "announcements" made by the characters that are portrayed as stick figures appearing on the display. There is no description of any dialogue between the characters or, in fact, any other interaction. All that is described is that a character appears and makes an announcement. Therefore, it is apparent that Ugawa does not describe the word exchange feature that appears in each of the pending claims. Therefore, *prima facie* obviousness cannot be established with regard to any pending claim based upon Ugawa considered by itself.

The addition of Fuchs to Ugawa provides no basis for establishing obviousness of any claim now pending. Fuchs appears to be concerned with a video version of a card game that does not employ the display of any characters, i.e., persons or representations of persons, that could engage in a dialogue. Therefore, no claim now pending could be properly rejected for obviousness based upon any potential modification of Ugawa by Fuchs.

In re Appln. of INAGAKI et al.
Application No. 09/830,415

For the foregoing reasons, all claims now pending are distinguishable from the prior art and, upon reconsideration, should be allowed.

Respectfully submitted,


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